

REMARKS

(A) STATUS OF THE APPLICATION

Applicants thank the Examiner for her explanation of the rejections in the Non-Final Office Action dated January 31, 2007.

(I) DISPOSITION OF CLAIMS

- (i) Claims 1-6, 8-10, 12, and 13 are pending in the application.
- (ii) Claims 7, 11, and 14-41 have been previously canceled.
- (iii) Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b).
- (iv) Claims 4 and 12 are rejected under 35 U.S.C. § 103(a).
- (v) Claims 1-6, 8-10, and 12-13 are rejected under 35 U.S.C. § 112, 2nd paragraph.

(II) APPLICANTS' ACTION

- (i) Applicants have amended Claim 1 to remove "body parts" from the substrate list. No new matter was added.
- (ii) Applicants respond to the above rejections.

In the ensuing discussion, comments under the sub-heading "Examiner's Comments" are attributed to the Examiner. Unless specified, Applicants do not generally agree with the assertions made by the Examiner under that sub-heading. Applicants give their views in the comments under the sub-heading "Applicants' Response."

(B) RESPONSE TO REJECTION UNDER 35 U.S.C. § 102(B) UNDER U.S. PATENT NO. 4,315,790 TO RATTEE, ET AL.—CLAIMS 1-3, 5-6, 8-10, & 13

(I) Examiner's Comments

Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,315,790 to Rattee, *et al.* (*hereinafter*, "Rattee").

Rattee teaches applying a composition to a fabric or any flexible substrate. The composition includes polymers such as acrylics. A layer of transferable composition

on a supporting flexible substrate such as paper, metal foil, or a plastic film is pressed on the fabric with heating. The layer is subsequently cured. The flexible substrate could be an automotive body part, such as car seat or "other flexible parts."

Therefore, Claim 1 is anticipated. Also, Rattee discloses such other limitations that anticipate Claims 2-3, 5-6, 8-10, and 13.

(II) Applicants' Response

Applicants respectfully disagree with the Examiner.

According to the MPEP § 2131.02(A) "[a] genus does not always anticipate a claim to a species within the genus." While "the disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited,"¹ and "when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named,"² neither of these are the case here.

In fact, the genus disclosed in Rattee is exceptionally broad, covering "any flexible substrate which needs to be decorated like a textile" (See Col. 1, Lines 10-11). With such a statement, one could envision that Rattee's flexible substrate is *anything* that is not rigid. Rattee also does not clearly name any species related to automobiles,³ only naming "textile fabrics" as a preferred subgenus (Col. 1, Lines 4-6). Applicants' substrates, on the other hand, are restricted to automotive bodies and body parts, a far narrower group than that disclosed in Rattee, and not part of the textile fabric subgenus.

However, in order to expedite prosecution, Applicants have amended Claim 1 to now include only "automotive bodies" as the substrate. The reference to "[automotive] body parts" is now deleted. Applicants submit that as a result of the amendment,

¹ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001).

² See MPEP § 2131.02(A).

³ The only species that appear to be named in Rattee are types of fabrics found in the examples, such as a knitted cotton T-shirt, mercerized cotton, cotton/polynosic rayon blend, woven cotton, and knitted polynosic rayon.

any allusion to seat covers or other flexible automotive body parts as being within the scope of Claim 1, is now moot.

In light of the amendment, Applicants respectfully submit that Rattee fails to anticipate Claim 1 of the invention. As such, the dependent claims thereto should also be novel.

(C) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(A) U.S. PATENT NO. 4,315,790 TO RATTEE, ET AL.—CLAIMS 4 & 12

(I) Examiner's Comments

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being obvious over Rattee.

The Examiner has applied arguments from the previous section for establishing *prima facie* obviousness of Claims 4 and 12. The Examiner also suggests that although Rattee does not teach a textured supporting substrate, it is an obvious variant of its process (for Claim 4). Secondly, although Rattee does not teach transparent compositions, Example 12 of Rattee, containing no pigment, would be transparent.

(II) Applicants' Response

Applicants respectfully traverse these rejections.

According to the MPEP § 2143.01(I), to establish a *prima facie* case of obviousness, *inter alia*, there must be some suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to produce Applicants' claimed invention. A broad disclosure of the decoration of "any flexible substrate which needs to be decorated like a textile" is *not* a suggestion to coat the automotive bodies, as claimed by Applicants. "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient

by itself to establish a *prima facie* case of obviousness.”⁴ Nothing in the remainder of Rattee provides such a suggestion, either.

In addition, Applicants respectfully submit that the amendment to Claim 1, which now includes only automotive bodies as substrate (as opposed to “[automotive] body parts”), clearly removes any allusion that flexible substrates (the main point of Rattee) are within the scope of Claim 1. Therefore, Rattee cannot be a 35 U.S.C. § 103(a) reference that obviates Claim 1.

Because a *prima facie* case of obviousness cannot be established against Claim 1, Applicants respectfully submit that dependent Claims 4 and 12 cannot be obvious over Rattee.

(D) RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, 2ND PARAGRAPH-CLAIMS 1-6, 8-10, AND 12-13

(I) Examiner’s Comments

Claims 1-6, 8-10, and 12-13 were rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Particularly, the phrase “automotive bodies and body parts” is indefinite because it is not clear whether the adjective “automotive” applies to both nouns, “bodies” and “body parts” or only to the noun “bodies.”

(II) Applicants’ Response

Applicants’ have amended Claim 1 that deletes “body parts” as a substrate. In light of the amendment, the indefiniteness rejection under 35 U.S.C. § 112, 2nd paragraph, is moot.

⁴ See generally MPEP § 2144.08(II).

CONCLUSION

In view of the above remarks, Applicants respectfully submit that the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Non-Final Office Action mailed on January 31, 2007.

Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited.

If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928.

Respectfully submitted,

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